

REMARKS

Claims 20 to 29 are pending in the present application after the cancellation herein of claims 10 to 19 without prejudice. In light of the foregoing amendments and the following remarks, Applicants respectfully submit that all pending claims are in condition for allowance, and reconsideration is respectfully requested.

I. Rejections of Claims 10 to 29 Under 35 U.S.C. § 103(a)

Claims 10 to 16, 18 and 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 6,070,813 ("Durheim") and U.S. Patent No. 5,744,780 ("Chang et al."). Claims 17 and 20 to 29 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Durheim, Chang et al. and U.S. Patent No. 6,630,645 ("Richter et al."). As an initial matter, claims 10 to 19 have been cancelled herein without prejudice, and, as such, the rejections regarding these claims are moot. It is respectfully submitted that the combination of Durheim, Chang et al. and Richter et al. does not render unpatentable claims 20 to 29 for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). It is respectfully submitted that the Office Action has clearly failed to establish a prima facie case of obviousness.

Independent claims 20 and 28 recite, inter alia, that **a backing is positioned tilted relative to at least one of an outlet opening and a workpiece.** Neither Durheim, Chang et al. nor Richter et al. disclose, or even suggest, at least this feature. Durheim and Chang et al. describe methods for laser drilling a workpiece. Both references disclose a backing. The backing, however, as described in Durheim and

Chang et al., is positioned without any tilting relative to an outlet opening. Richter et al. disclose a laser drilling method in which the drilling angle has an inclination with respect to a surface of a workpiece. Nowhere do Richter et al. disclose, or even suggest, a backing positioned tilted relative to at least one of an outlet opening and a workpiece. Indeed, in Richter et al. a backing is not even provided. In claims 20 and 28, the backing itself is tilted relative to at least one of a outlet opening and a workpiece. In Richter et al., a certain bore shape is achieved by moving the laser beam itself. The laser itself is steadily adapted to the desired shape of the bore being created. See, e.g., claim 1 of Richter et al., which states that “a laser moves in a number of neighboring paths, adapted in length and number to a form of the funnel.” In that manner, bores of a conical form may be achieved. See Richter et al., column 5, lines 33 to 35, which state that “[t]he funnel 9 may also be formed conically with a circular cross section.” Such conically running bores, which are formed by correspondingly guided laser devices, are mentioned in the Specification of the present application at, e.g., the section captioned “Background Information.”

For at least the reason that the combination of Durheim, Chang et al. and Richter et al. does not disclose a backing positioned tilted relative to at least one of an outlet opening and a workpiece, it is respectfully submitted that the combination of Durheim, Chang et al. and Richter et al. does not render unpatentable independent claims 20 and 28.

As for dependent claims 21 to 27 and 29, it is respectfully submitted that the combination of Durheim, Chang et al. and Richter et al. does not render unpatentable these dependent claims for at least the same reasons more fully set forth above.

For at least the foregoing reasons, withdrawal of these rejections is respectfully requested.

II. Conclusion

In light of the foregoing, Applicants respectfully submit that all pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

No fees are believed to be required in connection with this paper. Nevertheless, the Director is hereby authorized to charge any and all fees that may be required in connection with this paper or this application, including any required

extension of time fees under 37 C.F.R. §§ 1.17(a) or 1.136, to the deposit account of Kenyon & Kenyon LLP, Deposit Account No. 11-0600.

Respectfully submitted,

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